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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,229	11/30/2001	Yakov Kamen	007287.00015	6955

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EXAMINER	
RAMAN, USHA	
ART UNIT	PAPER NUMBER
2424	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/008,229	KAMEN ET AL.	
	Examiner	Art Unit	
	USHA RAMAN	2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Appeal Brief

1. In view of the appeal brief filed on March 23, 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 7 and 13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 7-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 recites "One or computer-readable media", wherein applicant's disclosure (see, page 14, [0029]) indicates various examples of a, "computer and/or machine readable media, such as....electrical, optical, acoustical and other forms of propagated signals (e.g. carrier waves, infrared signals digital signals, etc.)". Accordingly applicant's disclosure is evidence that the "computer readable media" can be merely represented as signals and therefore claims signals per se. Since, a signal is not a process, machine, manufacture or composition of matter and therefore not a patentable subject matter. See MPEP § 2106.

Claims 8-12 also recite computer readable media, claiming signals per se and are deemed non-statutory for reasons stated above.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7, last line is incomplete as it doesn't specify what the predetermined number is greater than, thereby rendering the claim indefinite. It is best understood to be greater than 1 and has been considered accordingly.

Claims 8-12 depend on indefinite claim thereby rendering its scope indefinite.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747)

With regards to claims 1 and 7, Candelore discloses a method comprising:

Providing a first set of categories of broadcast programs (EPG, see [0020]);

Providing a second set of categories of broadcast programs (favorites list 408); and

Adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcast program viewing device to

a broadcast program fitting into the first categories a predetermined number of times ([0045]-[0046], list of favorites is based on relative statistics maintained, wherein the relative statistics tracks the number of times a channel, program, actor, director or theme was accessed);

Candelore is silent on wherein the predetermined number of times is greater than 1.

In a related art, Bedard discloses maintaining viewer's favorite programming in a viewer profile array, wherein a profile entry for favorite is created only when a viewing unit for that entry is greater than one (col. 5, lines 7-9). Note that the statistics indicating the number of viewing units of Bedard is analogous to the number of times in the Candelore system.

It would have been obvious to one of ordinary skill in the art to modify the system of Candelore in view of Bedard by including only items with greater than 1 viewing units (i.e. items accessed more than 1 times) in the favorites list, thereby eliminating insignificant program/category/channel accesses from the favorites list.

With further regards to claim 7, Candelore further discloses one or more computer readable media storing instructions that when executed by a processor cause the processor to perform the above method [0041].

With regards to claim 19, Candelore further discloses wherein the first and second sets are located in a set top box [0019].

9. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747)

as applied to claims 1 and 7, respectively, above, and further in view of Blonstein et al. (US Pat. 5,978,043).

With regards to claims 2, and 8, the modified system is silent on the method further comprising removing a second category from the second set upon selecting the second category from the second set.

In an analogous art, Blonstein discloses a method of allowing user to remove an item from a favorites list upon selecting of the item from the second set (col. 12, lines 23-30). Such a method is facilitated in the event user no longer wants an item to be included in the favorites list.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Blonstein's teachings by allowing a viewer to select an item in the favorites list to remove the item from the favorites list to facilitate removal of an item user no longer wants to be included in the favorites list.

10. Claims 3-5 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747) as applied to claims 1 and 7, respectively, above, and further in view of Rothmuller (US Pat. 5,635,989).

With regards to claims 3, and 9, the modified system is silent on the method further comprising removing a second category from the second set upon a broadcast program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcast program predetermined to be in the second category from the second set.

In an analogous art, Rothmuller discloses a method of further tracking when a program from a favorites list was tuned to (col. 5, lines 62-65, col. 6, lines 26-31). The system additionally determines that a favorite program has not been tuned to for a predetermined time period and removes program from the favorites list upon such a determination (col. 6 lines 48-54). This helps ensure that favorites list is up to date with user's current favorites rather than older favorites that may no longer be of interest to the user.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Rothmuller by further tracking when an item was last accessed in a favorites list, and removing items that have not been tuned to for a predetermined threshold thereby purging older entries that are now irrelevant and ensuring that the favorites list is up to date with user's current viewing trends.

With regards to claims 4 and 10, the modified system is silent on the method further comprising, tuning a broadcast program viewing device to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program so that the program can be viewed/recorded.

With regards to claims 5 and 11, the modified system is silent on the method further comprising, tuning a broadcast program viewing device, upon a singular pressing of a button, to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15) upon a singular press of a button (i.e. AUTO-TUNE key). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program using an auto-tune button so that the program can be viewed/recorded.

11. Claims 6 and 12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Bedard (US Pat. 5,801,747)

as applied to claims 1 and 7, respectively, above, and further in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911).

With regards to claim 6, and 12, the modified system is silent on the method further comprising, verifying adding from the first set to the second set including receiving user input confirming the addition of the first category.

In an analogous art, Ellis discloses a method of when a user tunes to a program, presenting a prompt such as "set this program as a favorite?", responsive to which the program is added to favorites [0081].

In a further analogous art, Schein discloses a method of seeking user designation of specific criteria (e.g.) associated with a program a user considers to be a favorite.

It would have been obvious to one of ordinary skill in the art to modify the system in view of Ellis and Schein's teachings by presenting an on screen prompt to the user asking the user to designate specific criteria for favorites prior to entering it to the favorites list thereby confirming with the viewer the specific criteria/item (e.g. category) of a program to be included in the favorites list.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911).

With regards to claim 13, Candelore discloses a system comprising:

a first unit provide a first set of categories of broadcast programs (EPG 4A 406, see [0020]);

a second unit to provide a second set of categories of broadcast programs (favorites list 408) in response to selecting the category [0003] from the first set and tuning a broadcasted program viewing device, for a period of time at least equal to a first predetermined threshold ("certain period of time" [0045]), to at least one broadcasted program predetermined to be in the category from the first set [0045]-[0046],

Candelore discloses that various items (including category) pertaining to a program being viewed can be added to the favorites list. Candelore does not disclose the system comprising, wherein the second unit further includes a user verification wherein a user approves the category from the first set being added to the second set prior to the category being added.

In an analogous art, Ellis discloses a method of when a user tunes to a program, presenting a prompt such as "set this program as a favorite?", responsive to which the program is added to favorites [0081].

In a further analogous art, Schein discloses a method of seeking user designation of specific criteria (e.g.) associated with a program a user considers to be a favorite (col. 12, lines 15-18).

It would have been obvious to one of ordinary skill in the art to modify the system in view of Ellis and Schein's teachings by prompting the user to add a program and designated criteria corresponding to the program to the favorites, after a predetermined time of being tuned to that program, so that favorite list adds only items (e.g. user specified criteria on categories) related to the program that are

designated by user. When the user to designates a specific criteria corresponding to the program to be included in favorites upon being prompted, the user approves the category from the first list being added to the second set prior to the category being added.

With regards to claim 19, Candelore further discloses wherein the first and second sets are located in a set top box [0019].

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911) as applied to claim 13 above, and further in view of Blonstein et al. (US Pat. 5,978,043).

With regards to claim 14, the modified system is silent on the method further comprising removing a second category from the second set upon selecting the second category from the second set.

In an analogous art, Blonstein discloses a method of allowing user to remove an item from a favorites list upon selecting of the item from the second set (col. 12, lines 23-30). Such a method is facilitated in the event user no longer wants an item to be included in the favorites list.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Blonstein's teachings by allowing a viewer to select an item in the favorites list to remove the item from the favorites list to facilitate removal of an item user no longer wants to be included in the favorites list.

14. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore et al. (US PG Pub. 2002/0104081) in view of Ellis et al. (US PG Pub. 2005/0204382) and Schein et al. (US Pat. 6,323,911) as applied to claim 13 above, and further in view of Rothmuller (US Pat. 5,635,989).

With regards to claim 15, the modified system is silent on the method further comprising removing a second category from the second set upon a broadcast program viewing device not being tuned, for a period of time at least equal to a first predetermined threshold, to at least one broadcast program predetermined to be in the second category from the second set.

In an analogous art, Rothmuller discloses a method of further tracking when a program from a favorites list was tuned to (col. 5, lines 62-65, col. 6, lines 26-31). The system additionally determines that a favorite program has not been tuned to for a predetermined time period and removes program from the favorites list upon such a determination (col. 6 lines 48-54). This helps ensure that favorites list is up to date with user's current favorites rather than older favorites that may no longer be of interest to the user.

It would have been obvious to one of ordinary skill in the art to further modify the system in view of Rothmuller by further tracking when an item was last accessed in a favorites list, and removing items that have not been tuned to for a predetermined threshold thereby purging older entries that are now irrelevant and ensuring that the favorites list is up to date with user's current viewing trends.

With regards to claim 16, the modified system is silent on the method further comprising, tuning a broadcast program viewing device to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to the program (col. 8, lines 3-15). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program so that the program can be viewed/recorded.

With regards to claim 17, the modified system is silent on the method further comprising, tuning a broadcast program viewing device, upon a singular pressing of a button, to a channel on which a broadcast program predetermined to be in a second category from the second set will be broadcasted within a predetermined threshold of current time.

In an analogous art, Rothmuller discloses of alerting or notifying the user about airing of a program item identified as a favorite within a predetermined threshold of current time (col. 7, lines 39-45), and further allowing the user to tune to

the program (col. 8, lines 3-15) upon a singular press of a button (i.e. AUTO-TUNE key). By notifying the user when items from favorites list is about to air, the system can indicate to the user desirable programs that are about to air in the near future.

It would have been obvious to one of ordinary skill in the art by further modifying the system in view of Rothmuller by notifying the user of desirable programs that are about to air based on user's favorites list and tuning to the program using an auto-tune button so that the program can be viewed/recorded.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PG Pub 2003/0056216 to Wugofski et al.

US PG Pub. 2004/0034867 to Rashkovskiy et al.

US Pat. 6,721,953 to Bates et al.

US Pat. 7,434,246 to Florence

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to USHA RAMAN whose telephone number is (571)272-7380. The examiner can normally be reached on Mon-Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art Unit 2424

/Usha Raman/